

REMARKS

Claims 1- 6, and 8-10 are currently pending in the application. By this amendment, claims 1 and 8 are amended. Attached hereto is a separate sheet entitled "Clean Copy of Pending Claims, As Amended" showing a clean copy of the claims pending in the application, as amended.

The Examiner has rejected claims 8-10 under 35 U.S.C. §112, second paragraph, as being indefinite because dependent from a cancelled claim. This rejection is overcome by amending claim 8 to depend from claim 1.

The Examiner has rejected claims 1-3 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 6,035,288 to Solomon in view of U.S. Patent No. 6,125,352 to Franklin et al. ("Franklin"). Franklin teaches "selectively selecting and storing product information on a client-side database," as noted by the Examiner. However, Franklin is concerned with facilitating on-line shopping by providing a practical mechanism for the shopper to assemble product information and prices from a plurality of merchants and thereby comparison shop without being dependent upon storage of product information by the merchants. There is no description or suggestion in Franklin of capturing by the shopper of information enabling the shopper to establish a profile for negotiation. Comparison shopping of the kind disclosed in Franklin is old in the commercial world, and is made more convenient and extensive by on-line tools such as are provided by Franklin.

The present invention provides automation of aspects of the commercial transaction between merchant and customer not even considered by Franklin. Solomon addresses these aspects, but from the viewpoint of the merchant who wishes to simulate a pred-defined behavioral pattern for customers who enjoy "haggling" in a bazaar-like atmosphere (Solomon, col. 2, lines 9-10). All the information used for the simulation is captured and maintained on the merchant side of the transaction by

the merchant and, obviously, for the benefit of the merchant. There is no teaching or suggestion in Solomon of a system where each side of a bargaining transaction develops profiles of the other side in order to gain advantage in the bargaining. As the Examiner has acknowledged, Solomon "does not teach capturing by the customer the on-line e-commerce site's actions and formulating by the customer a profile of the on-line e-commerce site.":

The Franklin reference does not provide what is missing in Solomon. Franklin simply automates the price comparison shopping practices that are old in the art. Writing down the price/product information of different vendors ("selecting and storing product information") for the purpose of comparing prices and making a more informed buying decision is well known. There is nothing in Franklin (or in the old price comparison shopping practices) which describe or suggest going beyond this to gather and analyze the full range of information about the other party across the bargaining table, to establish a profile to be used to gain a bargaining advantage in a commercial transaction with the other party. Unilateral selection of the best price from among competing merchants does not suggest a "profile" as that term is used in the present invention. Thus, while price comparison shopping is well known and

obvious, applying this teaching to Solomon does not yield the present invention. Nor does Solomon provide any incentive for the present invention – which uses a merchant profile for the advantage of the customer – since Solomon provides a merchant profile for the advantage of the merchant. Indeed, Solomon teaches away from such a bilateral view of profiles in on-line bargaining.

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It should be noted that the bilateral character of the invention is expressly stated in the specification (page 12, line 22; see also page 2, lines 1-10). Consequently, certain amendments have been made to claim 1 to make clear the bilateral character of the invention.

The Examiner has kindly suggested that a difficulty with the claims is that a "profile" is established by any gathering of information, e.g. by the customer about a web site. This applies, for example, to the storing of a bookmark as described in the Gerace reference. However, the term "profile" as defined in the specification relates to those aspects of the party on the other side of a bargaining transaction which are relevant to the conduct of the negotiation. This notion of profile is different from other uses of the term, as for example is described in the background section of the specification with respect to the Cragan prior art at page 3, lines 2-12. Consequently, certain amendments have been made to claim 1 which appropriately qualify the term "profile" to make the term particular to what is intended by the specification.

In view of these amendments and the foregoing remarks it is believed that claim 1 is now in proper condition for allowance.

The Examiner has rejected claims 4 and 5 under 35 U.S.C. §103(a) as unpatentable over Solomon in view of Franklin and U.S. Patent No. 5,991,735 to Gerace. Since claims 4 and 5 depend from claim 1, which is now believed to be in allowable form as described above, this rejection is also overcome. It should be noted that Gerace teaches about customer profiles and does not describe or suggest customer capturing of profiles of the e-commerce site.

The Examiner has rejected claim 6 under 35 U.S.C. §103(a) as unpatentable over Solomon in view of Franklin and further in view of U.S. Patent No. 5,717,923 to Dedrick. Since claim 6 depends from claim 1, which is now believed to be in allowable form as described above, this rejection is also overcome. It should be noted that Dedrick teaches about customer profiles and does not describe or suggest customer capturing of profiles of the e-commerce site.

The Examiner has rejected claims 8-10 under 35 U.S.C. §103(a) as unpatentable over Solomon in view of an article by E. Birkhead, "Digging with Gopher," in *LAN Computing*, Vol. 5, no. 4 (April 1994) p. 23 ("Birkhead"). Since

claims 8-10 depend from claim 1, which is now believed to be in allowable form as described above, this rejection is also overcome. It should be noted that while Birkhead teaches the well known practice of establishing bookmarks by a user, these bookmarks are not a “profile” of the e-commerce sites bookmarked and, indeed, bookmarks by a user may better pertain to the profile of the user. Apart from the context of other bookmarks – which reflect the profile of the user – the bookmark is simply a web address (a URL) and says nothing whatsoever about the e-commerce site “profile” as that term is used in the specification and in the claims as amended.

In view of the foregoing, it is requested that the application be reconsidered, that claims 1-6 and 8-10 be allowed, and that the application be passed to issue.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at 703-787-9400 (fax: 703-787-7557; email: clyde@wcc-ip.com) to discuss any other changes deemed necessary in a telephonic or personal interview.

If an extension of time is required for this response to be considered as being timely filed, a conditional petition is hereby made for such extension of time. Please charge any deficiencies in fees and credit any overpayment of fees to Deposit Account 09-0441 (IBM-Almaden).

Respectfully submitted,



Clyde R Christofferson
Reg. No. 34,138



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PATENT TRADEMARK OFFICE